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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Michael B. McGraw et al.

Serial No.: 09/556,389

Filed: April 24, 2000

Confirmation No.: 7261

For: PORTABLE MUSCLE STIMULATOR
WITH PULSE WIDTH CONTROL

Art Unit: 3762

Examiner: S. Getzow

Atty. Dkt. No.: 000309.00011

MCG/DJE:

PETITION UNDER 37 C.F.R. §1.182

Commissioner for Patents

Date: June 4, 2002

Washington, D.C. 20231

Repln. Ref: 10/01/2002 AKELLEY 0011370500

DAH:232185 Name/Number:09556389

FC: 704 Sir: \$130.00 CR

The Petitioners, through undersigned counsel, respectfully petition under 37 C.F.R. §1.182 for a refund of all fees paid pursuant to certain submissions filed after final rejection, namely, Notice of Appeal and Request for Extension of Time filed October 11, 2001, and the Continued Prosecution Application (CPA) Request Transmittal and Request for Extension of Time filed May 13, 2002. It was necessary to file those submissions to prevent the above-captioned application from becoming abandoned after final rejection, in light of over a year's worth of unreasonable delays in the U.S. Patent and Trademark Office through no fault of and beyond the control of the Petitioners. The total amount of fees for which a refund is sought is \$3,480.00.

The petition fee under 37 C.F.R. §1.17(h) is enclosed herewith.

06/06/2002 AOSMAN1 00000008 09556389

01 FC:122 130.00 OP

Adjustment 00309.00011/01/2002 AKELLEY

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The Final Rejection was dated April 11, 2001, and set a shortened statutory period for response of three months. The sole ground of rejection was that the reissue declaration was unsigned. The Response to Final Rejection, submitting the same reissue declaration with the inventors' signatures, was filed April 17, 2001, which was less than a week after the date of the Final Rejection.

The Petitioners' counsel reasonably believed that the Response was fully responsive and would result in a Notice of Allowance. The Examiner evidently thought so as well, since the Petitioners' counsel was informed that an allowance was counted on April 30, 2001.

However, a Notice of Allowance was never mailed. Instead, the application was sent to a review process which extended beyond the six-month statutory period for responding to the Final Rejection. The next communication from the USPTO was dated October 18, 2001, which was after the end of the six-month statutory period and more than six months after the date on which the Response to Final Rejection had been filed.

During that period of six months, the Petitioners' counsel had made several attempts to learn the status of the review process to which the application had been submitted, although no one to whom they spoke at the USPTO could provide information. Since the Petitioners' counsel had no way of knowing the status of the review process, they filed the Notice of Appeal and Request for Three-Month Extension of Time to prevent the application from becoming abandoned. Petitioners' counsel did not know and could not have known that a further communication from the USPTO would come only a week after the end of the statutory period for response.

The communication from the USPTO dated October 18, 2001, was a request for a Supplemental Declaration on a form provided by the USPTO. The executed Supplemental Declaration

was filed by facsimile directly in the technology center on October 26, 2001.

As far as the Petitioners or their counsel had been made aware, all outstanding requirements made by the USPTO were met, and the application was in condition for allowance. The Examiner apparently thought so as well, since counsel was informed that an allowance was counted on November 19, 2001.

However, a Notice of Allowance was not mailed. Instead, the application was submitted again to the same review process. The Petitioners' counsel spoke with the Examiner, his SPE, and the SPRE conducting the review to learn the status of review. However, as of May 13, 2002, which was the final date for taking action to prevent abandonment of the application (May 11 being a Saturday), the application was still in the review process, and no one could determine when the review would be completed. It was therefore necessary to file the CPA and to pay for five months' extension of time to prevent abandonment of the application.

In summary, the allowance was first counted in the above-captioned application more than a year ago. During most of that time, the application has been in review by the SPRE. To prevent abandonment of the application during that year, the Petitioners have had to file the various submissions listed above and to pay government fees totaling \$3,480.00, all because the application has been in review for roughly a year.

For the reasons set forth above, the Petitioners respectfully submit that the payment of government fees on October 11, 2001, and May 13, 2002, was necessitated by unreasonable delay in the USPTO, which the Petitioners' counsel had no way of controlling or predicting. Accordingly, the Petitioners respectfully submit that they are due a refund of \$3,480.00 for such fees. The Petitioners further request that the fee for the present Petition be refunded upon grant of the Petition.

In the event there are any questions relating to the present Petition or to the application in general, it would be appreciated if the appropriate officer at the USPTO would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

The Office is authorized to charge any shortage of fees or credit any overpayment thereof to BLANK ROME COMISKY & McCAULEY LLP, Deposit Account No. 23-2185 (000309-00011). In the event that a separate Petition for an Extension of Time is required, the Petitioners herewith petition under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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